



AF/3622

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

CHASE A. HAFNER et al.

Group Art Unit: 3622

Examiner: D. Champagne

Serial No.: 09/421,038

Filed: October 20, 1999

For: METHOD FOR MANAGING INFORMATION
AND RENDERING DISCOUNTS

Attorney Docket No.: 1668 (USW 0535 PUS)

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GROUP 3600

REPLY BRIEF

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Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231

Sir:

This is a reply brief in response to the Examiner's answer of November 8, 2002.

Appellants acknowledge the Examiner's changes to the first paragraph of the issue section of the appeal brief. More specifically, Appellants agree that the issue is whether claims 1, 10 and 11 are anticipated under 35 U.S.C. § 102(b) and, alternatively, unpatentable under 35 U.S.C. § 103(a).

The Examiner disagrees with Appellants' statement in the appeal brief that certain claims do not stand or fall together. Appellants clarify and modify the statement as

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follows: With regard to anticipation by Benyacar of claims 1, 10 and 11, these claims stand or fall together. With regard to anticipation by Jagadish of claims 1-4, 6-14 and 16-19, these claims stand or fall together with the exception of claims 6 and 16. With regard to unpatentability of claims 5 and 15 over Jagadish, these claims stand or fall together. Claims 6 and 16 are believed to recite additional patentable subject matter as explained in Appellants' brief at page 10, lines 14-20.

Appellants maintain the positions taken in the appeal brief. Appellants address the Examiner's response to the argument below.

The Examiner acknowledges that Appellants note correctly that the terms must be interpreted in view of one of ordinary skill in the art. Appellants believe that the Examiner has incorrectly interpreted "rule-based accumulation engine" and "rule-based discount engine" and similar terms. Appellants believe that page 2, lines 8-15 of the specification, taken in light of page 1, line 7 - page 2, line 3 (background art), when read by one of ordinary skill in the art does give considerable guidance for the definitions of "rule-based accumulation engine" and "rule-based discount engine." Specifically, Appellants maintain the position taken in the appeal brief at page 7, line 7 - page 8, line 14.

The Examiner gives his definition of the claim terms based strictly on page 2, lines 8-15, of the specification. Appellants disagree with the Examiner's definition. In addition, Appellants maintain that the Examiner must consider the claim terms in light of the entire specification when read by one of ordinary skill in the art as opposed to a single mention at several lines of the summary. Appellants understand that the background art discussion describes the prior art and that examples in the detailed description are made in reference to an exemplary implementation. Nevertheless, consideration should still be given to the entire specification and to the level of skill in the art when determining the meaning of claim terms. Appellants believe that consideration of the entire specification and the level of ordinary skill in the art of rule-based expert systems gives guidance for the term meanings as argued in the

appeal brief. The Examiner characterizes Appellants' arguments as an attempt to import limitations. In contrast, Appellants argue the meaning of terms already present in the claims. Further, the Examiner hints that an enablement rejection under 35 U.S.C. § 112 first paragraph may be appropriate, but no such rejection has been made nor has any explanation been offered as to what information is missing from the specification and why such information could not be supplied by one of ordinary skill in the art. Appellants believe that the invention is enabled by the specification as a whole. Appellants note that the term "rule-based engine" itself is enabling to one of ordinary skill in the art. In addition, the exemplary embodiment provides further enablement.

The Examiner states that Appellants introduce the rule-based accumulation/discount engines without associating them with the background discussion. Although it is true that the claims must particularly point out what the invention is, Appellants maintain that it is appropriate that the background art may and in this case does point out what the invention is not. Appellants have presented arguments for the meaning of the claim terms and believe that the Examiner's meaning is incorrect. That is, the well-known manner of bill generation used by Benyacar does not necessarily perform the claimed invention when proper meanings are given to the claim terms. For example, the well-known manner of bill generation used by Benyacar could be the existing method for rendering discounts described in the background section of Appellants' patent application (what the invention is not) as opposed to being the method recited by independent claim 1 (what the invention is). As such, a rejection based on inherency is improper.

The interpretation of the terms "rule-based accumulation engine" and "rule-based discount engine" is critical in assessing the patentability of the claimed invention. Appellants maintain that the specification as a whole does give considerable guidance to one of ordinary skill in the art for the definitions of these terms. The Examiner has elected to give these terms an incorrect and overly broad meaning that improperly goes beyond the broadest reasonable interpretation to one skilled in the art. The rejections are then based on inherency.

Although Appellants and the Examiner have different opinions as to the correct interpretation of the recited claim terms, resulting in some difference of opinion as to what the invention is, Appellants point out that there is clarity as to what the invention is not. That is, the invention is not, as explained in the background art of the specification, an existing method using a complex application specific software package developed for a particular billing system of a single company and having a highly defined structure. It is clear that one of ordinary skill in the art would not interpret the claim terms in a way that is so far from Appellants original intentions so as to read on the existing method described in the background art. Because the relied upon prior art could use this existing method (which is outside of any proper scope of the claims) as opposed to the claimed method, rejections based on inherency are clearly improper. Previously, Appellants presented arguments as to proper claim term interpretation. Here, Appellants point out that any claim term interpretation results in inherency rejections being improper.

Lastly, the Examiner does make some conclusory statements that the advantages of non-application specific software are obvious and rule-based software has been mentioned in the literature since at least 1989 so it is very likely that an obviousness rejection of the claims could be constructed even if Appellants' interpretation of rule-based accumulation/discount engine is accepted. Appellants disagree. Appellants do not believe that an obviousness rejection of the claims would be appropriate. First, there is no motivation to modify the prior art to achieve the claimed invention, and no such motivation has been referenced by the Examiner, only conclusory statements with regard to obviousness have been

made. Second, based on the present record, such an obviousness rejection amounts to the taking of official notice of the entire invention, which is clearly improper.

Respectfully submitted,
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